

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* SHUICHI HIRAYAMA

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Appeal 2007-0197  
Application 10/076,956  
Technology Center 3700

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Decided: June 29, 2007

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Before WILLIAM F. PATE III, TERRY J. OWENS, and  
MURRIEL E. CRAWFORD, *Administrative Patent Judges*.

TERRY J. OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellant appeals from a rejection of claims 6-13 and 15-28, which are all of the pending claims.

THE INVENTION

The Appellant claims a boot liner. Claim 8 is illustrative:

8. A boot liner comprising:

a sole portion; and

an upper portion having a foot section fixedly coupled to said sole portion, an ankle section extending upwardly from said foot section and a leg section extending upwardly from said ankle section, said upper portion including a thermoformable layer located on an inner side and an outer side of said ankle section, a first banana-shaped pad located in said outer side of said ankle section, and a second banana-shaped pad located in said inner side of said ankle section,

said upper portion including a tightening device fixed thereto with a first strap portion overlying a part of said first banana-shaped pad and a second strap portion overlying a part of said second banana-shaped pad,

said first and second banana-shaped pads being configured and arranged to support an ankle joint of a wearer of said boot liner at bottom and rearward sides of the ankle joint of the wearer.

#### THE REFERENCES

Garbuio	US 3,925,916	Dec. 16, 1975
Clement	US 5,746,015	May 05, 1998
Breuner	US 5,775,006	Jul. 07, 1998
Pozzobon	US 6,012,236	Jan. 11, 2000

#### THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 6, 7, 9-13, 17-21, 23, 26 and 27 over Pozzobon in view of Garbuio and Clement, and claims 8, 15, 16, 22, 24, 25 and 28 over Pozzobon in view of Garbuio, Clement and Breuner.

#### OPINION

We reverse the aforementioned rejections. We need to address only the independent claims, i.e., claims 8, 13 and 28.

### Claim 13

The Appellant's claim 13 requires first and second banana-shaped pads located respectively in outer and inner sides of a boot liner ankle section, the pads being constructed of a different material than a thermoformable layer located on the inner and outer sides of the ankle section.

Pozzobon discloses an interboot comprising an outer lining (2) coupled to a first layer (3) of thermoformable material having holes (4) passing through it and the outer lining (col. 2, ll. 50-54; fig. 2). Coupled to the first layer is a second layer or film (5) of vapor-permeable material having one or more channels (7) therein (col. 2, ll. 65-60). The inner surface of the second layer or film may have thereon an inner lining (8) (col. 3, ll. 20-22).

Garbuio discloses a foot-fitting boot liner insert comprised of a flexible sheet outer material (2) inside which is an elastomeric core (4) sandwiched between a pair of resin-impregnated fabric layers (3) to form an airtight envelope around the core (col. 2, ll. 10-14; 21-24). An enclosed seam (7) around the fabric layers forms two major lateral areas (A), one on each side of the insert (col. 2, ll. 14-17; fig. 2). Garbuio discloses a pair of elastic pads, the entire discussion regarding which is as follows:

[A] pair of elastic pads **8** (one on each side) may be juxtaposed with the insert **2** in the region of the ankles for additional protection, the material of these pads being substantially denser than that of the core portion **4a**. Pads **8** may consist of the same solid (i.e. nonfoamed) elastomeric material as the core portions **4** surrounding the area A, e.g. polyurethane. Any lateral pressure acting upon this pad will be distributed by the resilient core **4a** over the entire area A for effective

cushioning of the foot without materially impeding its mobility.  
[col. 2, ll. 28-38]

Garbuio's figure 1, which shows a lined boot, includes one of the pads, whereas figure 2, which is a side-elevational view of the figure 1 insert without the boot, does not show the pad.

Clement discloses a ski boot comfort liner comprising wedging elements (5,6) that have micro-perforations through their thickness and are interposed between an exterior or semiflexible liner wall (11) and a comfort fabric inner liner wall (12) (col. 3, ll. 12-15; col. 4, ll. 5-10, 27-28; fig. 2).

The Examiner argues that Garbuio's elastic pad 8 is banana shaped and that Garbuio "teaches that it is desirable to have these pads located on the inner boot to allow for a better and more snug fit of the boot to the user's foot" (Answer 4). Garbuio discloses that elastic pad 8 is "juxtaposed with the insert 2" (col. 2, l. 29) but does not disclose that elastic pad 8 is located on the insert. Garbuio's figure 2, which shows the insert without the boot (col. 1, ll. 67-68), does not include elastic pad 8. Also, the Examiner does not point out, and it is not apparent, where Garbuio teaches that elastic pad 8 allows for a better and more snug fit of the boot to the user's foot. Garbuio's teaching is that elastic pad 8 provides additional protection in the ankle region (col. 2, ll. 28-30).

The Examiner argues that Clement would have led one of ordinary skill in the art to place Garbuio's elastic pad 8 inside Pozzobon's liner to provide for better and proper cushioning of the boot on the user's foot (Answer 4-5), but the Examiner has provided no supporting evidence or technical reasoning.

The Examiner's arguments indicate that the reason relied upon by the Examiner for placing Garbuio's elastic pad 8 inside Pozzobon's liner comes from the Appellant's disclosure rather than the applied references and that, therefore, the Examiner used impermissible hindsight in rejecting the Appellant's claim 13. *See W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960). Accordingly, we conclude that the Examiner has not carried the burden of establishing a prima facie case of obviousness of the invention claimed in that claim.

#### Claims 8 and 28

In addition to the first and second banana-shaped pads required by claim 13, claims 8 and 28 require that the upper portion of the boot liner includes "a tightening device fixed thereto with a first strap portion overlying a part of said first banana-shaped pad and a second strap portion overlying a part of said second banana-shaped pad".

Breuner discloses a strap (56) that goes around the top of a boot upper (38) and helps close the boot's tongue (40) down onto the upper (col. 6, ll. 15-17; figs. 1, 3).

The Examiner argues that "it would have been obvious, to place a tongue on the inner boot upper as well as straps to attach the outer boot to the inner boot and prevent the ingress of material into the boot" (Answer 8). That is the function of Breuner's strap (56) around the outside of the boot ("[t]his strap is fastened and tightened to close the tongue of the boot close

to the ankle and to prevent snow and cold from reaching the inside of the boot”; col. 3, ll. 41-43). The Examiner has not established that, in light of the disclosure that the strap around the boot performs that function, one of ordinary skill in the art would have been led to fix a strap to the boot liner. Hence, for this additional reason, the Examiner has not set forth a prima facie case of obviousness of the inventions claimed in the Appellant’s claims 8 and 28.

#### DECISION

The rejections under 35 U.S.C. § 103 of claims 6, 7, 9-13, 17-21, 23, 26 and 27 over Pozzobon in view of Garbuio and Clement, and claims 8, 15, 16, 22, 24, 25 and 28 over Pozzobon in view of Garbuio, Clement and Breuner are reversed.

#### REVERSED

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